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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/026,336	02/19/1998	MASAHIDE TANAKA	06205.0007	1637

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EXAMINER

VU, NGOC YEN T

ART UNIT PAPER NUMBER

2612

DATE MAILED: 05/21/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/026,336

Applicant(s)
Masahide TANAKA et al.

Examiner
Ngoc-Yen Vu

Art Unit
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 ~~is~~/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 ~~is~~/are rejected.
- 7) ☒ Claim(s) 13 is/~~are~~ objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: **2612**

Response to Amendment

1. The amendments, filed 03/05/2003, have been entered and made of record. Claims 1-20 are pending and examined.

Response to Arguments

2. Applicant's arguments filed 03/05/03 have been fully considered but they are not persuasive.

With respect to the Harris reference, the Applicants argue that Harris does not teach or suggest receiving means for receiving an identification signal back from a remote device in response to the designation of said remote device. The Examiner respectfully disagrees. Harris teaches that the communication device 104 can be configured to be in a telephone mode, a video conferencing mode, a note taking mode, or a camera mode. In the telephone mode or the video conferencing mode, the user of the communication device 104 can initiate the telephone mode or the conferencing mode by placing a call to the other party (designation of a remote device). The reception of the call and the ongoing process between parties in the telephone mode, and the image of the other party on the display of the communication device 104 in the video conferencing mode inherently indicate that an electromagnetic signal containing an identification signal transmitted back in response to the designation of a remote device.

With respect to the Brusewitz reference, the Applicants argue that Brusewitz does not teach or suggest the use of “means for receiving an identification signal back from a remote

Art Unit: 2612

device in response to the designation of said remote device". In response to the above arguments, the Examiner does not rely on Brusewitz for the teaching of the claimed receiving means. Harris teaches this claimed limitation, not Brusewitz. The Applicants further argue that Brusewitz also does not teach or suggest controlling means for controlling said displaying means in a first mode and in a second mode as recited in claim 4 of the present invention. The Examiner respectfully disagrees. Harris teaches that the display 184 can display photo snapshots and video clips stored in the image memory (col. 12 lines 24-30). Brusewitz also teaches that the display 28 can display motion images at low resolution and still images at desired resolutions as requested by a user.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reducing the number of pixels of a still image prior to transmission) are not recited in the rejected claim(s) as previously claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2612

4. Claims 1-12 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US #6,009,336) in view of Brusewitz et al. (US #6,038,257).

In view of the Applicant's amendments to claims 1, 3, 11, 18 and 19, the interpretation of the Harris reference has changed as follows. Regarding claims 1 and 3, Harris '336 teaches a digital still camera comprising means for converting an optical image into a digital image signal (Fig. 1, CCD camera 188; col. 12 lines 5-30);

transmitting means (RF transceiver 126 & radio circuitry 114) for transmitting an electromagnetic signal to a designated remote device accessible in accordance with a wireless telephone system;

means for receiving (RF transceiver 126 & radio circuitry 114) from said remote device an identification signal to be transmitted back in response to the designation of said remote device (col. 9 line 17 - col. 10 line 5; col. 10 line 47 - col. 11 line 7);

modifying means (DSP 128 & DSP 152) for modifying the electromagnetic signal into a digital image signal (col. 3 line 40 - col. 4 line 60);

reducing means (DSP 152) for reducing the number of pixels of the image represented by said digital electronic image signal prior to transmission and in response to the identification signal (col. 4 lines 36-45).

Claim 1 differs from Harris in that the claim requires the electromagnetic signal containing a still image represented by the digital image signal, and means for receiving the electromagnetic signal at the designated remote device. However, it is well known in the art that

Art Unit: **2612**

video imaging devices such as CCD cameras are able to capture and transmit motion and still images, as taught in Brusewitz '257. Brusewitz teaches a sending device (8; see Fig. 1) which can operate in a normal video mode at a usual video resolution or in a still image mode at a high resolution according to a user's request (col. 5 line 5 - col. 7 line 29). It is noted that Brusewitz also teaches that for the purpose of reducing the transmission time and bandwidth of the image, a low resolution version of a high resolution still image is created and transmitted as requested (col. 5 line 5 - col. 6 line 17). Brusewitz further teaches that the still image requests can be generated automatically and the invention is applicable for wireless communications (col. 7 line 58 - col. 8 line 25). In light of the teaching from Brusewitz, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device taught in Harris by transmitting a still image at a desired resolution to a remote device as desired by video conference viewers.

As to claim 2, Harris teaches that the DSP 128 and DSP 152 form a digital image signal without reducing the number of pixels. Although Harris, as modified by Brusewitz, does not explicitly teach that the reducing means is inoperative when the receiving means fails to receive the identification signal transmitted from the remote device, it would have been obvious to one of ordinary skill in the art to recognize that still images are transmitted without reducing the number of pixels if there is no request from a remote device.

Regarding claims 4-12 and 14-20, the subject matter in these claims can be found in claims 1-3. It is noted that Harris, as modified by Brusewitz, teaches displaying means (Fig. 1,

Art Unit: 2612

display 184) for alternatively displaying a still image having high resolution or low resolution as desired by the user of the hand-held imaging device. It is noted that Harris teaches means for receiving audio input (DSP speech processing 130 and microphone 151), means for transmitting the audio input as part of the electromagnetic signal (radio circuitry 114; the communication device 104 is operate under video conferencing mode); and mane for converting the audio input as part of the electromagnetic signal back into an audio output (DSP speech processing 130 and speaker 149).

Allowable Subject Matter

5. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: **2612**

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any response to this office action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc-Yen Vu whose telephone number is (703) 305-4946. The examiner can normally be reached on Mon. - Fri. from 8:00 a.m. to 4:30 p.m..

Art Unit: **2612**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-0377.

NYV
05/15/2003



NGOE-YEN VU
PRIMARY EXAMINER